APP 19 PAGE 1

(5)

Supreme Court, U.S.
FILED
MAY 30 2003
CLERK

No. 02-429

IN THE

Supreme Court of the United States

DETHMERS MANUFACTURING COMPANY, INC.,

Petitioner,

v.

AUTOMATIC EQUIPMENT MANUFACTURING COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SUPPLEMENTAL BRIEF FOR PETITIONER

DENNIS W. JOHNSON
Counsel of Record
BRIAN J. LAURENZO
MICHAEL C. GILCHRIST
DORSEY & WHITNEY LLP
801 Grand Avenue
Des Moines, Iowa 50309
(515) 283-1000

Attorneys for Petitioner

181078

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

5 pp

RULE 29.6 STATEMENT

The Petitioner is Dethmers Manufacturing Company, Inc. Petitioner does not have a parent corporation. There are no parent or publicly held companies owning ten percent (10%) or more of the Petitioner's stock.

In his amicus brief on behalf of the United States, the Solicitor General states that "this case presents significant and potentially far-reaching issues of patent law. The Federal Circuit . . . resolved those issues incorrectly, in violation of the governing statutory requirements and decisions of this Court." U.S. Brief at 8. Nevertheless, the Solicitor General recommends waiting for a later date and later case to resolve these important issues. Contrary to the Solicitor General's suggestion, this is the right time and the right case for these issues to be resolved.

The Solicitor General bases his suggestion to wait for a better case in part on the fact that the Federal Circuit has not yet had the opportunity to apply its *Nupla* decision to the revised version of Rule 175. Changes to Rule 175, however, do not affect the questions presented here. The particular procedural requirements of Rule 175 are irrelevant to the issues of whether a patent that complies with statutory requirements can be invalidated for failure to comply with a procedural rule and whether the PTO's determination of compliance with its own procedural rule is entitled to judicial deference.

Waiting for a case applying revised Rule 175 will not result in a better vehicle to present the "important and recurring issues" (U.S. Brief at 1) raised in this appeal. Neither the Federal Circuit's determination that it can invalidate a patent based on a non-statutory ground nor its view that it does not need to give deference to the PTO's interpretation of its own regulations is based on the particular requirements of Rule 175. Furthermore, because the Federal Circuit is the only circuit that typically reviews patent related issues, and because the Federal Circuit has conclusively spoken on the issues here--in the form of its current and previous panel decisions and its evenly divided refusal to rehear the case *en banc* (complete with extensive dissents from that refusal)--these

"important" problems will remain "recurring" (U.S. Brief at 1) unless this Court corrects them.

The Solicitor General suggests that certiorari should be denied because, in other situations, the Federal Circuit has declined to invalidate a patent for failure to comply with a procedural rule. Given that the Federal Circuit has exclusive jurisdiction over patent appeals, however, this conflicting precedent, along with the even split among the judges, is analogous to a split in the circuits. Unless this Court grants review, the error in this case will become engrained into the law, and will "narrow[ ] the patent protection afforded by Congress" (U.S. Brief at 10), thereby significantly reducing the value of reissue patents. While reissued patents may reflect a relatively smaller percentage of patents, they are also significantly more likely to be involved in litigation than are other patents. More fundamentally, the principles involved regarding non-statutory grounds for invalidating a patent and judicial deference to PTO rule interpretation affect all patents.

The Solicitor General also argues that a better case to review the questions squarely presented here might arise in the context of a case that has been appealed to the Board of Patent Appeals and Interferences (Patent Board). However, the issues presented in this case relate to issued patents, and appeals to the Patent Board deal only with pending applications; therefore, it is extremely unlikely that such a case will ever in fact arise.[1] The case at hand

---

[1] The case envisioned by the Solicitor General could occur in the unusual instance where the patent examiner issued a final rejection of the application for failure to comply with the rule, the applicant appealed that ruling to the Patent Board, the Patent Board reversed the examiner on that issue, the patent application matured into a reissue patent, the reissue patent became the subject of a lawsuit, and compliance with the rule became an issue in that lawsuit.

represents an instance where the PTO itself filed two briefs with the Federal Circuit expressing its views on the matter. It is unlikely that any case will arise where these issues have been more thoroughly developed below.

This is the right case and the right time for the Court to correct the Federal Circuit on these "important and recurring issues."

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

Dennis W. Johnson
Counsel of Record
Brian J. Laurenzo
Michael C. Gilchrist
Dorsey & Whitney LLP
801 Grand Avenue
Des Moines, Iowa 50309
(515) 283-1000
(515) 283-1060 (fax)

Attorneys for Petitioner